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10/667,470

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Rajeev A. Jain

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EXAMINER

KWON, BRIAN YONG S

ART UNIT

PAPER NUMBER

1614

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/667,470	<b>Applicant(s)</b> JAIN ET AL.	
	<b>Examiner</b> Brian-Yong S. Kwon	<b>Art Unit</b> 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 27-50, 54-106 and 110-111 is/are pending in the application.
- 4a) Of the above claim(s) 54-86, 110 and 111 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-50 and 87-106 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :IDS filed 03/27/09, 03/13/09, 02/12/09, 10/29/08, 10/09/08, 09/10/08, 12/17/07, 10/13/06, 07/12/06, 09/23/03.

## **DETAILED ACTION**

### ***Status of Application***

1. Acknowledgement is made of applicants' filing of the instant application as a Request for Continued Examination (RCE) under 37 CFR 1.1114.
2. Acknowledgement is made of applicant's amendment/declaration filed on 11/13/2009. By the amendment, claims 27 and 87 have been amended. Claim 27-50, 54-106 and 110-111 are currently pending in the application, but claims 54-86 and 110-111 were withdrawn from consideration as being drawn to the non-elected invention. Claims 27-50 and 87-106 are currently pending for prosecution on the merits of the instant application.
3. Applicant's arguments have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of actions being applied to the instant application.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 27-47, 50 and 87-106 rejected under 35 U.S.C. 102(b) as being anticipated by Eickhoff et al. (USP 5518738). This rejection is analogous to the previous rejection mailed 11/12/008.

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Eickhoff teaches a rapidly-acting (“more rapid onset of action”) solid oral dose form pharmaceutical composition comprising “poorly soluble” active drugs in nanoparticulate form, for example anti-inflammatory agent such as NSAIDs in crystalline phase and nanoparticulate, dispersed in mixtures of hygroscopic sugar (i.e., mannitol), polyvinylpyrrolidone and sodium lauryl sulfate, wherein the polyvinylpyrrolidone surface modifier mixed with the hygroscopic sugar and sodium lauryl sulfate is adsorbed on the surface of the active drug (abstract; column 2, lines 41-50; column line 59 through column 3, line 32; column 3, lines 36-48; column 5, lines 45-52; claims 1-10 and 15; claims 1-10, particularly claim 4), wherein the average particle size of the active is less than about 1000 nm, preferably less than 300nm (column 3, lines 49-59); the concentration of the active is in range from about 0.1 to 60% (column 4, lines 16-21; the concentration of polyvinylpyrrolidone is in range from about 0.1 to about 90% (column 4, lines 21-24 and column 5, lines 42-44); the concentration of the hydrogroscopic sugar (i.e., mannitol) in range of from 10 to 75% (column 5, lines 53-54); and the concentration of the sodium lauryl sulfate is in range of from 0.1 to 10% (column 5, lines 55-57); and the dispersion is sprayed dried to a fine powder in a fluidized bed coater or the final composition is prepared in caplets (Examples). Eickhoff also discloses a method of treating a mammal comprising administering said composition (see claims 11-14).

Although Eickhoff discloses the NSAIDs as the preferred class of drugs in said oral dose form, for example an oral solid dosage form comprising nanoparticulate naproxen (approximately 200 nm) having mixtures of polyvinylpyrrolidone, mannitol and sodium lauryl sulfate dispersant adsorbed on the surface (Examples 1 and 2), Eickhoff expressly teaches that

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other active drugs such as antibiotics can be utilized in replace of NSAIDs (column 2, lines 49-51).

With respect to “the solid dose matrix surrounding the nanoparticulate active agent and at least one surface stabilizer disintergrates or dissolves upon contact with saliva is less than about 3 minutes”, such property or characteristic deems to be inherent to the referenced “more rapid onset of action” composition since the essential components of Eickhoff are identical to the instant composition (that is an oral solid dose rapidly disintegrating nanoprticulate having an average particle size of less than 1000nm and water-dispersible excipient and/or a surface stabilizer (i.e., polyvinylpyrrolidone, mannitol and sodium lauryl sulfate)). Thus, Eickhoff anticipates the instant invention.

With respect to the specific average particle sizes, the referenced average particle size of the active, e.g., less than about 1000 nm, preferably less than 300nm, more preferably 200nm, “metes and bounds” the instantly required particle size and thus anticipates the claimed invention.

With respect to the specific amounts of active agent or excipient in said composition, the referenced concentration of the active agent which is in range from about 0.1 to 60% and the referenced concentration of polyvinylpyrrolidone which is in range from about 0.1 to about 90% “metes and bounds” the instantly required amounts of active and/or excipients and thus anticipates the claimed invention.

With respect to “said excipient is selected from the group consisting of a direct compression material and a non-direct compression material”, such property or characteristic

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deems to be inherent to the referenced excipients such as mannitol. Thus, Eickhoff anticipates the instant invention.

It is noted that *In re Best* (195 USPQ 430) and *In re Fitzgerald* (205 USPQ 594) discuss the support of rejections wherein the prior art discloses subject matter which there is reason to believe inherently includes functions that are newly cited or is identical to a product instantly claimed. In such a situation the burden is shifted to the applicants to "prove that subject matter shown to be in the prior art does not possess characteristic relied on" (205 USPQ 594, second column, first full paragraph).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 27-50 and 87-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eickhoff et al. (USP 5518738) in view of applicant's admitted prior art of record (pages 1, line 31 through page 4, line 22) or Acosta-Cuello (WO 97/18796 A1).

The teaching of Eickhoff has been discussed in above 35 USC 102(b) rejection.

Applicant's admitted prior art of record and WO'796 are provided as supplemental references to demonstrate the routine knowledge in preparing micro- or nano-particulate compositions in a rapidly disintegrating or dissolving or fast-melting solid oral dose or matrix form (see particularly page 1, line 31 through page 4, line 22 of the instant specification; abstract, page 5, lines 19 through page 6, line 5 of WO'796).

Alternatively, assuming arguendo that Eickhoff's formulation differs from the instant invention (i) mainly in the feature of "rapidly disintegrates upon contact with saliva in less than three minutes" recited in claim 87.

However, such determination of appropriate dosage form having rapidly disintegrating dosage form upon contact with saliva in less than about 3 minutes for treatment involving each of the above mentioned formulations would have been routinely made by those of ordinary skill

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in the art and is within the ability of tasks routinely performed by them without undue experimentation, especially in light of the known dosage formulation art.

As evidenced by the applicant's admitted prior art or WO'796, there are general references indicating that pharmaceuticals generally may be delivered rapidly dissolving formulations, as well as disclosing benefits to be achieved by "rapidly dissolving formulation" or "fast melt" dosage forms versus other modes of administration. Therefore, there exist general art accepted motivations for formulating drugs for "rapidly dissolving formulation" or "fast melt" dosage forms.

With respect to the preparation of said composition via lyophilization, applicant's admitted prior art of record (particularly page 3, lines 13-22) teaches the routine knowledge in preparing fast disintegrating oral dosage form or fast melt dosage formulation via free-drying techniques. Above references in combination make clear that the preparing said rapidly disintegrating or dissolving dosage formulation or fast melt dosage forms made by various techniques including fluid bed granulation or lyophilization is well known and within the skill of artisan. Thus, one would have been motivated to combine these references and make the modification because they are drawn to same technical fields (constituted with same ingredients and share common utilities), and pertinent to the problem which applicant concerns about. MPEP 2141.01(a).

6. Claims 27-50 and 87-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eickhoff et al. (USP 5518738) in view of applicant's admitted prior art of record (pages 1, line 31 through page 4, line 22) or Acosta-Cuello (WO 97/18796 A1), and further in view of

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Kerkhof et al. (WO 01/45674 A1). See above 35 USC 103 (a) rejection. This rejection is analogous to the previous rejection mailed 11/12/008.

Similar to Eickhoff, Kerkhof disclose nanoparticle compositions comprising a nonsoluble drug including analgesics, anti-inflammatory agents including NSAIDs such as indomethacin, naproxen and ketoprofen, antibiotics, anthelmintics, anti-arrhythmic agents, anticoagulants, antidepressants, antidiabetic agents, antiepileptics, etc... in water-dispersible excipient (i.e. mannitol, lactose, carbonates, bicarbonates, etc...), and/or surface stabilizer such as surfactant (i.e., polyvinylpyrrolidone, sodium dodecylsulfate (commonly known as sodium lauryl sulfate), carboxymethylcellulose, etc...), wherein said composition is made by fluid bed granulation and spray-drying method where a suitable excipient, such as spray-dried lactose, is fluidized by an upward gas stream; and wherein one part by weight of an active ingredient is combined with about 2.5 to about 50 parts, preferably about 2.5 to about 20 parts of an excipient (abstract; page 10, lines 1-12; page 10, line 25 through page 11, line 9; page 11, lines 10-27; page 15, lines 1-18; page 8, lines 11-16 and 25-27; page 15, lines 1-17; page 12, line 29 thru page 13, line 6; Claims, particularly claims 1-2, 7, and 19). According to Kerkhof, the nanoparticle can have a mean particle size between 50-1000 nm (Claim 2 and page 7, lines 20-23). The composition can be fashioned into tablets, capsules or syrups (page 14, lines, 12-15). According to Kerkhof, the method of preparing a nanoparticle composition can comprise spraying a solution of a poorly soluble drug and a solvent into a bed of carrier particles (claim 1). The solution may further comprise a surface modifier, such as a surfactant (claims 1, 18, 19). The nanoparticle composition can have a mean particle size of around between 50-1000nm (claim 2 and page 7, lines 20-23). Kerkhof also disclose a method of administering a nanoparticle composition

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comprising a surface modifier, such as a surfactant, and a drug to a human (page 14, lines 16-27). Prior to administration, the composition may be formulated into a tablet (page 14, lines 12-15).

The modified teaching of Eickhoff (combination of Eickhoff et al. and the applicant's admitted prior art of record or WO'796) includes all that is recited in the claimed invention except the specific particle size or the active agent, namely "less than about 100 nm", more particularly "less than about 50 nm" recited in claims 94 and 95 respectively and "the poorly soluble active agent is in the form of crystalline particles, semi-crystalline particles or amorphous particles" recited in claim 106. To incorporate such teaching into the modified teaching of Eickhoff, would have been obvious in view of Kekh Hof who teaches the routine knowledge in preparing nanoparticle of a nonsoluble active (e.g., antibiotics and anti-inflammatory agent including NSAIDs such as indomethacin, naproxen and ketoprofen) to a mean particle size between 50-1000nm in carrier excipients and/or surface stabilizer and the use of effervescent such as bicarbonate in said composition.

Above references in combination make clear that the determination of the specific (nano) particle size of the poorly soluble active agent required in the instant invention and the use of bicarbonate in said composition as a secondary ingredient in areas of pharmaceutical dosage art are well known. Thus, one having ordinary skill in the art would have been motivated to combine the references and make such modification to extend the usage of said composition in rapidly disintegrating nanoparticulate form to accommodate patient's preference and needs where the compliance could be improved with effective and well tolerated drug.

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One would have been motivated to combine these references and make the modification because they are drawn to same technical fields (constituted with same ingredients and share common utilities), and pertinent to the problem which applicant concerns about. MPEP 2141.01(a).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 27-50 and 87-106 are rejected under the judicially created doctrine of double patenting over claims 1-24 and 51-70 of USP 6316029. This rejection is analogous to the rejection on the record.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and the patent are directed to a oral solid dose rapidly disintegrating nanoparticulate formulation comprising water-soluble or water-dispersible excipient and a poorly soluble active agent less than about 200 nm prior to inclusion in the dosage forms and at least one surface stabilizer.

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8. Claims 27-50 and 87-106 are rejected under the judicially created doctrine of double patenting over claims 1-16 and 21 of USP 6165506, further in view of the applicant's admitted prior art of record (page 3, lines 13-22). This rejection is analogous to the rejection on the record.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and the patent are directed to a oral solid dose nanoparticulate formulation comprising water-soluble or water-dispersible excipient and a poorly soluble active agent less than about 200 nm prior to inclusion in the dosage forms and at least one surface stabilizer.

Since the transitional term "comprising" is inclusive or open-ended and does not exclude additional, unrecited elements or method steps, the inclusion of alkali agent to increase the dissolution rate of nanoparticulate naproxen disclosed in US'506 falls within the scope of the invention and makes obvious the instant invention.

Although USP'506 is silent about the characteristic of said composition having "rapidly disintegrating", such property or characteristic deems to be inherent to the referenced composition since the essential components of USP'506 are identical to the instant composition. Thus, USP'506 makes obvious the instant invention.

9. Claims 27-50 and 87-106 are rejected under the judicially created doctrine of double patenting over claims 1-177 of US 7276249, and further in view of applicant's admitted prior art of record (pages 1, line 31 through page 4, line 22) or Kerkhof et al. (WO 01/45674 A1). This rejection is analogous to the rejection on the record.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the instant invention overlaps with the patented claims.

Although independent claims of 1, 64, 121, 178 and 184 of US'249 do not specially recite the instant "at least one pharmaceutically acceptable water soluble or water-dispersible excipient", it is clear from reading the referenced claims 42-50, 56, 99-103, 105-113, 118, 156-160, 162-170 and 175 that said composition is prepared in the water soluble or dispersible excipients. Thus, US'249 makes obvious the instant invention.

With respect to the instantly required rapidly disintegrating or dissolving property of said composition in claim 87, such determination of suitable dosage delivery form is considered obvious task for the skilled artisan especially in view of the referenced claim 34, .97 and 154. Thus, USP'249 makes obvious the instant invention.

With respect to the instantly required specific nanoparticle sizes of the active drug and the specific amounts of active and inactive ingredients in claims 91-101, such optimization of known active and/or inactive ingredients is considered obvious task for the skilled artisan especially in view of the referenced claims 11-24, 26-29, 74-92, 114-115 and 131-149. Thus, USP'249 makes obvious the instant invention.

With respect to the preparation of said composition via "spray-dried mannitol and spray-dried lactose", "fluid bed granulation" or "lyophilized" or the preparation of said composition with "a direct compression material and a non-direct compression material", namely mannitol or lactose and effervescent agent, such determination of suitable technique to make "fast melt" or "rapidly disintegrating or dissolving" drug or using known secondary ingredients in is considered obvious task for the skilled artisan especially in view of the referenced claims 34-35, 97-98 and 154-155 and applicant's admitted prior art of record (pages 1, line 31 through page 4, line 22) or Kerkhof et al. (WO 01/45674 A1). Thus, USP'249 makes obvious the instant invention.

In looking in continuity data, it is noted that applicant has numerous issued patent and pending applications encompassing the same or similar subject matter of the instant application. Applicant should review all subject matter considered the same or similar, and submit the appropriate Terminal Disclaimer(s). For example, 09/337675, 11/275069, 10/392303, 12/068706, etc... are drawn to same or similar subject matter(s).

### ***Response to Arguments***

10. Applicant's arguments/declaration filed 11/13/09 have been fully considered but they are not persuasive.

Applicant's argument in the response takes the similar position as 08/11/2008 and 02/12/09 that Eickhoff does not teach a solid dose matrix surrounding the nanoparticulate active agent and at least one surface stabilizer disintegrates or dissolves upon contact with saliva in less than about 3 minutes. Applicant asserts that a solid dose matrix recited in the instant claims is shown as a porous matrix surrounding the active agent particles and upon contact with saliva, the excipients forming the solid dose matrix are anticipated to rapidly hydrate and dissolve or swell, thereby resulting in rapid disintegration of the solid dosage forms.

As discussed in O.A. mailed 11/12/2008 and 05/19/2009, the term "matrix" is generally recognized as "something within or from which something else originates, develops, or takes form" (Merriam-Webster Online Dictionary). In other words, given "broadest reasonable interpretation", the instant solid dose matrix containing the nanoparticulate active agent and at least surface stabilizer is construed to mean any solid dose form containing same components.

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Since the analysis of the instant claims requires nothing more than said components in a mere structure of solid dose matrix which will show some degree of disintegration or dissolution of said matrix or dose form in less than about 3 minutes when it is contact with saliva, the examiner determines that the prior art oral solid dose form containing same components or elements which is disclosed as “more rapid onset of action following oral administration”, for example in the form of caplet, must inherently possess such characteristic when it is contacted with saliva and thus anticipates the claimed invention.

Applicant’s argument in the response takes the position that the examiner’s reliance of the instant specification as being admission of the routine knowledge in preparing micro- or nano-particulate compositions in a rapidly disintegrating or dissolving solid oral dose or matrix form is in err. Applicant alleges that “the specification explicitly discloses that as of the priority date for the present application a fast-melt dosage form was not available in a nanoparticulate active agent form”.

This argument is not found persuasive. Unlike the applicant’s argument, the examiner’s notion is similar to the applicant’s recognition that various technologies involving rapidly disintegrating or dissolving or fast-melting solid oral dose or matrix form was readily available at the time of invention was made. In other words, there are general references indicating that pharmaceuticals generally may be delivered a rapidly disintegrating or dissolving or fast-melting solid oral dose or matrix form, as well as disclosing benefits to be achieved by a rapidly disintegrating or dissolving or fast-melting solid oral dose or matrix form versus other modes of administration. Therefore, there exist general art accepted motivations for formulating drugs

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including anti-inflammatory agent for a rapidly disintegrating or dissolving or fast-melting solid oral dose or matrix form of administration.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Again, the applicant's admitted prior art of the record makes clear that the preparation of poorly soluble drugs having nanoparticulate form via lyophilization technique was well known at the time of the invention was made (see also USP 5384124). Thus, one having ordinary skill in the art would have been motivated to extend the usage of said composition. One would have been motivated to make such modification to increase solubility and/or improve disintegration rate to accommodate patient's preference and needs where the compliance could be improved with effective and well tolerated dosage regimen.

In response to applicant's argument that the inclusion of alkali agent to increase the dissolution rate of nanoparticulate naproxen is different from the claimed invention and very specific for nanoparticulate compositions comprising naproxen, the examiner recognizes that the transitional term "comprising" allows for the inclusion of additional component such as alkali agent in said composition and makes obvious the instant invention. As discussed above, since the

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essential components of USP'506 which exhibits "unexpectedly rapid dissolution" or "rapid onset of action" are considered identical to the instant composition, USP'506 makes obvious the instant invention.

### Conclusion

11. No Claim is allowed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Kwon whose telephone number is (571) 272-0581. The examiner can normally be reached Tuesday through Friday from 9:00 am to 7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, can be reached on (571) 272-0718. The fax number for this Group is (571) 273-8300.

Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications may be obtained from Private PAIR only. For more information about PAIR system, see <http://pair-direct.uspto.gov> Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

/Brian-Yong S Kwon/  
Primary Examiner, Art Unit 1614

